

REMARKS

In an Office Action dated October 21, 2003, restriction to one of the following inventions was required:

- I. Claims 1-3 and 11, drawn to a method of treatment or prophylaxis of an inflammatory disease wherein stressor is oxidative conditions, classified in Class 424, subclasses 93.7 and 577;
- II. Claims 1-3 and 11, drawn to a method of treatment or prophylaxis of an inflammatory disease wherein stressor is ultraviolet radiation, classified in Class 424, subclasses 93.7 and 577; and
- III. Claims 1-10, drawn to a method of treatment or prophylaxis of an inflammatory disease wherein stressor is both oxidative conditions and ultraviolet radiation, classified in Class 424, subclasses 93.7 and 577.

In response, Applicants elect, with traverse, Group III.

The restriction is traversed because Applicants contend that the Restriction is improper. Specifically, Applicants request that the Examiner withdraw the restriction requirement and recast as an election of species requirement.

Applicants respectfully assert that the restriction requirement as set forth in the Office Action of October 21, 2003 was improper. The restriction requirement was in error because under the statute (35 U.S.C. § 121, MPEP 802 and 803), restriction is appropriate when two or more *independent and distinct* inventions are claimed in separate claims in one application.

Applicants submit that it is improper for the Office to refuse to examine that which Applicants regard as their invention when the subject matter of a single claim exhibits unity of invention. (MPEP 803.02). Specifically, in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978), the court articulated the general proposition that:

[A]n applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

Id. at 331.

Furthermore, Applicants assert that even where a provisional election of a single species is proper prior to examination on the merits, following election the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. (MPEP 803.02). The MPEP requires that should no prior art be found that anticipates or renders obvious the elected species, the search of the claim *will be* extended to non-elected species (plural). (Id.). The MPEP states that the search need not be extended unnecessarily to cover all non-elected species; however, the MPEP states that Applicant is entitled to consideration of claims to a *reasonable number of disclosed species* in addition to the elected species. (MPEP 809.02(b), emphasis added). Applicants disclosed 3 examples of stressors; ultraviolet radiation, oxidative, and combinations thereof and clearly such is a reasonable number of species.

As such, Applicants request that the restriction be recast as an election of species so that Claim 1 may be examined on the merits.

Applicants suggest the following species of stressors:

1. Ultraviolet radiation
2. Oxidative stressors
3. Combination of ultraviolet radiation and oxidative stressors

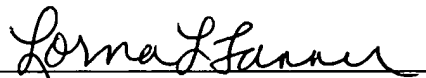
If the Examiner agrees with Applicants proposal, Applicants would like to elect no. 3, directed to a combination of ultraviolet radiation and oxidative stressors.

Early examination on the merits is respectfully requested. In the event that a telephone conversation could expedite the prosecution of this application, the Examiner is requested to call the undersigned at (650) 856-3704.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant(s) petition(s) for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 50-2859** referencing docket no. 559082003100.

Respectfully submitted,

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